



**Response under 37 C.F.R. 1.116
- Expedited Examining Procedure -
Examining Group 1752**

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

Paul L. Zengerle, et al

**METHOD OF PREPARATION OF
DIRECT DISPERSIONS OF
PHOTOGRAPHICALLY USEFUL
CHEMICALS**

Serial No. 10/692,535

Filed 24 October 2003

Commissioner for Patents
P.O. Box 1450
Alexandria, VA. 22313-1450

Sir:

Group Art Unit: 1752

Examiner: Amanda C. Walke

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Valerie J. Richardson
Valerie J. Richardson

December 14, 2005
Date

Pre-Appeal Brief Request for Review

Applicants request review of the final rejection in the above-identified application. No amendments are being filed with this request. This request is being filed with a Notice of Appeal. The review is requested based on the following Arguments

Arguments

Claims 1-36 are rejected under 35 U.S.C. 102(b) as being anticipated by Connelly et al (5,998,120) or Saito et al (6,220,925). This rejection represents clear error, as the Examiner has failed to identify where in either reference there is an actual disclosure that would anticipate the claimed combination of limitations of Applicants' process for making a direct dispersion claim 1, resulting direct dispersion claim 35, and photographic element claim 36 comprising such a direct dispersion.

The present invention describes an improved method for making direct dispersions of photographic useful materials (PUMs) for incorporation into silver halide photographic elements. In particular, the present invention teaches

the use of low levels (i.e., weight ratio relative to the amount of PUMs does not exceed 0.25) of specified organic solvents (i.e., those having a boiling point of at least 150C, a molecular weight less than or equal to 300, and a solvatochromic parameter β value greater than or equal to 0.50) specifically in a direct dispersion making process. As employed in the photographic art, "direct" dispersion making process are distinguished from other dispersion making processes by the feature that the PUM is homogenized or dispersed into an aqueous solution in the substantial absence of any auxiliary solvent (see, e.g., page 2, lines 19-21). As demonstrated in the examples, the specific solvents required in accordance with the claimed invention have been found to be particularly advantaged over other organic solvents for their ability to reduce to oil phase solution at temperatures used in the direct dispersion process. In particular, with the enhanced solubility characteristics that they provide, a much wider variety of high melting PUM's become amenable to the direct dispersion making process. They also enable direct dispersions to be prepared at reduced permanent solvent loads to facilitate thinner coated layers and reduced material (solvent and gelatin) laydowns, which lowers manufacturing cost. They also allow direct dispersion oil phases to be prepared at lower temperatures to avoid coupler decomposition problems, which may be commonly encountered with the direct process.

The Examiner reproduces large sections of the texts of each of Connelly et al and Saito et al, and in each instance concludes that "[g]iven the teachings of the reference, the instant claims are anticipated." The Examiner clearly fails to indicate, however, where in each such cited reference a teaching of the particular combination of requirements of the presently claimed invention may be found. Specifically, e.g., while Connelly teaches the use of various types of gelatins, photographically useful materials, and solvents in the preparation of a direct dispersion, and while Saito et al teaches the use of a combination of pyrrolotriazole couplers and non-color forming cyclic imide compound with a diffusion-resistant group and a wide variety of possible solvents, there is no specific teaching in either reference of the use of solvents meeting the requirements of the present invention at the claimed solvent to photographically useful material weight ratio in a direct dispersion making process. In particular, the solvent to photographically useful material weight ratios in dispersions prepared in all the Examples of the cited references appear to be well above the

present claimed requirement, and there is further no specific teaching to employ any specific solvents at necessarily lower weight ratios so as to be a teaching that could be said to otherwise fairly anticipate the present claimed invention. Thus, rejection of the present claims as anticipated by either reference represents clear error on this point alone, and reconsideration of this rejection is accordingly again respectfully requested.

The Examiner additionally states in the Final rejection that Applicant's arguments that there is no teaching in either of the references that the weight ratio of the specific solvent(s) to the PUMs in the material is 0.25 or less have been fully considered but they are not persuasive. While acknowledging that there is no specific teaching of this ratio being preferred by either reference, the Examiner states that it "appears" by looking at the teachings of the amounts in the body of the specification and in the examples, that this limitation for the ratio is met by each of the references. Again, however, such conclusion statement made by the Examiner as to what the cited references "appear" to disclose is simply not supported by any actual teaching in the cited references with respect to the actual combination of requirements of Applicants' claimed invention. To the contrary, as indicated above, the solvent to photographically useful material weight ratios in dispersions prepared in all the Examples of the cited references appear to be well above the present claimed requirement.

Further, while not rejected as obvious over the cited prior art, it is additionally clear that Connelly et al and Saito et al are directed towards solving different problems than that of the present invention, and that there is accordingly no teaching or suggestion that would lead one skilled in the art to the present invention. For both references, e.g., there is no mention of the desire to minimize solvent levels with direct dispersions, and no teaching of any combination of solvent parameters that would facilitate solvent minimization in direct dispersions. It is further noted with respect to Saito et al., that most of the phosphates and amides listed and referenced by the Examiner are high MW solvents, which are outside the scope of the present invention. Further, this reference in any event teaches the use low boiling (50 – 160C) auxiliary solvents in dispersion preparation (note all of the dispersion making examples employ high levels of ethyl acetate (BP = 77C)), contrary to the direct dispersion teachings of

the present invention. Clearly, in addition to not anticipating the present claimed invention, such references accordingly further do not establish any prima facie case of obviousness with respect to the present claimed invention, and allowance of the present claims over such references is respectfully urged.

The final rejection thus clearly is in error for at least the reasons asserted above, and a prompt and favorable action in response to this request is earnestly solicited.

Respectfully submitted,



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If the Examiner is unable to reach the Applicant(s) Attorney at the telephone number provided, the Examiner is requested to communicate with Eastman Kodak Company Patent Operations at (585) 477-4656.